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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,901

09/18/2003

Neil C. Young

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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

YW

<b>Office Action Summary</b>	<b>Application No.</b> 10/665,901	<b>Applicant(s)</b> YOUNG ET AL.	
	<b>Examiner</b> M. A. Sager	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-41 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 26-31, 34-39 and 41 is/are rejected.  
 7) ☒ Claim(s) 32, 33 and 40 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/11/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Information Disclosure Statement***

1. The information disclosure statement filed 2/11/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, there is no copy for non-patent literature relating to Diablo and no copy of cited reference was provided/cited in parent application. Thus Diablo has not been considered, but all other references have been considered.

***Claim Objections***

2. Claim 38 is objected to because of the following informalities: 'providing' for – provided--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 31, 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 recites the limitation "the news story" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 39 recites 'data to related to' which appears incomplete or at least confusing.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 26 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by background admission of prior art.

7. Claim 26, 30, 39, 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Park (5733131). Park discloses a device with dynamic configuration and operation (4:9-15:49, figs. 1-13) teaching the steps of method comprising delivering an episode of content (4:9-45, 4:53-5:6, 5:20-10:65) wherein the initial episode comprises an initial set of technology enabling an initial episode of content (sic), delivering subsequent episodes at periodically scheduled intervals to at least one user including a relevant current event news story (updated news/weather reports, television/education series) and delivery of technology updates by third-party vendor (6:58-7:3, 10:48-65, 12:46-15:49). Park delivers programs incrementally as data packets that become linked or constructed as a single control message (sic), thus new features [technology] is provided incrementally. Park incorporates Gaskill.

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8. Claim 26-31 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Miles (6102406).

9. Claim 26-27, 34-35, 37-38 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eichstaedt (6381594). This demonstrates breadth of claim language. Eichstaedt discloses a method for information generation (6:18-29) teaching claimed steps, as broadly claimed.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 34-36 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Park. Park discloses a method comprising claimed features (supra) including where transmitting to a voice mailbox includes a pager system with text to speech to cause device to enunciate a desired message at user (4:53-5:19, 7:43-9:).

Alternatively, Park's pager system with text to speech circuitry is an obvious equivalent process

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for sending a message to a user's voice mailbox at least due to a message is directed to a user based on addressing where the message is enunciated to a user.

13. Claim 34-35, 37-38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miles in view of Eichstaedt. Miles fails to disclose use of voice or facsimile as mode of transmitting messages. However such method of communicating were well known prior to the invention at least as demonstrated by Eichstaedt. Therefore, it would have been obvious to an artisan at a time prior to the invention to add voice mailbox and facsimile number as well known as demonstrated by Eichstaedt to Miles' device to permit user to retrieve messages using a wireless phone or fax machine which increases accessibility. Alternatively, the equivalence of sending a message to a user using email or to facsimile number or to voice mailbox is noted. Miles teaches use of email, but lacks facsimile number or voice mailbox. The difference between these steps/features and that which is clearly taught by Miles lie in the method of sending a message. As these features/steps are variations of communicating as are known, such would have been obvious to one of ordinary skill in the art in implementation of Miles. Absent criticality, specific delivery of message scheme falls within the realm of choice by game designers, when implementing a particular communication scheme onto Miles device. The lack of criticality of the specific recitations in the claims is evidenced by the art or Applicant's disclosure which further teaches these variations to be equivalent choices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add voice mailbox or facsimile number as an equivalent communication method to Miles device in order to increase accessibility by allowing different forms of communicating with user.

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*Allowable Subject Matter*

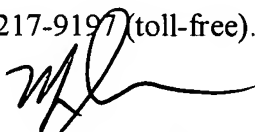
14. Claim 32-33, 40 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gaskill discuss communication protocol in paging system. Also, it is generally known that ISPs [such as CompuServe, Prodigy, AOL] provided user preference for receiving news, financial, weather, horoscope or other data at least since mid 1990's which provided periodic updates of selected data and periodic updates of version of ISP software.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 703-308-0785. The examiner can normally be reached on T-F, 0700-1700 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MARK SAGER  
PRIMARY EXAMINER